

REMARKS/ARGUMENTS

1. Claim 1 of the application has been amended to include the limitations that were previously set forth in claims 5 and 10 of the application and has been amended for clarity. These amendments are supported by the specification and add no new matter to the application. Acceptance of these amendments is respectfully requested.
2. Claims 3 and 4 have been amended to improve their clarity.
3. Claims 5 and 7 have been canceled and the subject matter incorporated into claim 1.
4. Claim 6 has been amended to resolve issues of dependency based upon the cancellation of claim 5.
5. Claim 10 has been amended to include the limitations of claim 16 therein.
6. Claims 12 and 14 have been amended to improve their clarity.
7. Claims 16 and 18 have been canceled.
8. Claim 17 has been amended to resolve issues of dependency occasioned by the cancellation of claim 16.
9. None of these claims add any new matter to the specification and acceptance of these claims is respectfully requested.

Claim Rejections - 35 USC § 103

10. The Examiner rejected claims 1-9 under §103(a) as being unpatentable (obvious) in view of Malecki et al when combined with Moose.
11. The Examiner argues that the Malecki reference discloses a pair of jaws that are pivotally connected to a base portion configured for sliding engagement along a holding rail, and an articulating device that is configured to manipulate the jaws so as to engage and stretch an endless loop.
12. The features that are shown in Fig 28A which are cited by the Examiner are described in the Malecki patent as follows: See US. Pat. No. 5,855,590 col 17 lines 48-67

“Figs 28A-28C shows three different views of a clamp 304C which uses a

rotatable actuating element. Clamp 304C includes first and second jaws, 308C, 310C, having somewhat outwardly bowed jaw surfaces 312C, 314C so that they do not touch along their entire surfaces. Jaws 308C, 310C are also preferably curved when viewed from the side shown in Fig 28C.”

“Arms 308C, 310C are pivotally mounted to opposite ends of a clamp base 396. Clamp base 396 has a threaded central hole through which a threaded shaft 398 passes. The shaft 398 rotates within this threaded hole in the base 396 so that rotation displaces the shaft axially relative to the base. The clamp positioner, similar to that shown in Fig. 25, is preferably used to rotate a hex head 400 while preventing base 396 from rotating. A connector 402 is coupled to a distal end of the shaft 396. Connector 402 is coupled to first and second jaws 308C, 310C by links 404, 406 so axial displacement of shaft 398 moves jaws 308C, 310C between the open solid line positions to the closed dash line position.”

13. It is clear from the description that this reference is not analogous art, does not teach a device for applying a castration loop, nor does it teach a device that includes a base portion that is connected to jaws and which is slid along a horizontal rail. The Malecki teaches a surgery clamp with jaws that are advanced by rotating a threaded rail between them.

14. The Examiner argues that combining the Malecki reference with the Moose reference would provide all of the features which are claimed in the present invention.

15. The Examiner argues that the Moose reference teaches the adding of the following features to the teaching of the Malecki reference: endless loops of endlessly stretchable material, lever that advances the loop and the base portion along the rail when moved in a generally downward direction, second pivot portions configured to connection with a brace arm. The Examiner argues that it would have been obvious to a person of skill in the art to combine these references and that such a reference teaches all of the features of the present invention.

16. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

17. The aims of the two references which have been cited by the Examiner are directly contrary and opposed. The Malecki reference teaches a device that clamps or holds another item shut. It is typically utilized in surgery where selected amounts of necessary pressure must be applied. The Moose invention is a device that spreads an endless ligation band that can be placed upon or over another item so as to achieve a desired goal, namely the removal of an undesired body part.

18. The Malecki reference teaches pairs of opposing jaws that are configured so as to not touch. The Moose reference teaches loop expanding portions that must touch so as to enable the loop to be placed upon the device.

19. The Moose reference teaches a device that has two positions, an open position and a closed position. The Malecki reference, utilizing a threaded rail, allows for infinite variation in the number of positions in which the clamp can be placed. This configuration also requires a significantly longer period of time in order to move from the fully open to the fully closed position because the threaded portion must be rotated so as to achieve advancement or retraction of the base, and therefore the opening or closing of the jaw arms. The Moose reference allows for smooth transitions between the open and closed positions as is consistent with the use in which the Moose device is utilized.

20. In as much as the ends of these two devices are opposed and the structures which are in place to achieve these ends are also opposed, the two references teach away from their intercombination. There would not be any suggestion or motivation to a party of skill in the art to combine these references. Including the threaded rail which is shown in the Malecki reference with the Moose reference would result in a device that would be cumbersome and useless for its intended purpose. Similarly modifying the Maleki reference to include the endless loop engaging portions of the Moose device would be exactly contrary to the purposes of this invention and would not provide any additional features or use to this invention.

21. Therefore, there is no suggestion or motivation to combine the references. And there is no reasonable expectation of success that would arise from such an intercombination. In as much as these required elements are lacking. Applicant respectfully submits that a *prima facie* case of obviousness has not been made.

22. While it is improper to use hindsight reasoning to assemble portions from references to arrive at a designated combination, even if the Moose and Malecki references were combined this combination would not produce the present invention. There are many features which are lacking.

23. As noted previously all of the claims of the present invention require that the base plate slide along a holding rail. The references which have been cited by the Examiner fail to teach this feature.

24. Neither of the references which have been cited by the Examiner include a lever that must be moved downward in the process of castration which is required by claim 1. In as much as there is no lever taught in the prior art references, there is no teaching of any of the other claimed features which interact with the lever.

25. The Examiner's reference to the handles of a pair of pliers as meeting this requirement is flawed in several instances. First such an orientation ignores that in the process of performing castration the testicles that are being removed hand down and the loop that is placed upon them must be raised around the testicles. If the Moore device were to be modified for such a use, there would be no downward extending lever because the item which the Examiner has cited as being equivalent to a lever would be positioned, and moves in a generally horizontal plane and not a vertical plane.

26. Furthermore, the Moore reference also clearly shows that the handles of the pliers in that device are integrally formed with the jaws and hence the jaws do not move according to the movement of a base plate. Disassembling these jaws and connecting them to the base plate that is shown in the Malecki reference would destroy the function of the Moore device.

27. In as much as there is no lever taught there cannot be any teaching of secondary lever support structures or pivot pins which connect the holding rail to the lever. The claims of the present application also make clear that the holding device of the present invention is distinct and different from the lever while the Examiner's rejection either mixes the two does not teach the limitation that the holding rail have a grasping portion attached to one end. The Moose reference does not teach this feature either.

27. While other differences also exist, the reasons enumerated above clearly show that none of the references which have been cited by the Examiner, nor combinations thereof, teach a device that has all of the features of the claims of the present invention in their new simplified and amended form. (As set forth in claims 1 and 10 of the application as amended or in the various dependent claims that depend therefrom.) In as much as these features of the present invention are lacking in the references that have been cited by the Examiner, Applicant respectfully submits that the invention is not an obvious modification of the prior art and respectfully requests the entry of the amendments and allowance of these claims.

Examiner Timothy J. Neal
Serial # 10/772,763

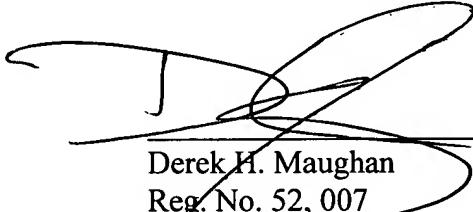
Conclusion

Reconsideration and allowance of the application as amended is respectfully requested.

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

DATED this 5th day of October, 2006

Very respectfully,



Derek H. Maughan
Reg. No. 52,007
~~(208) 345-1122~~

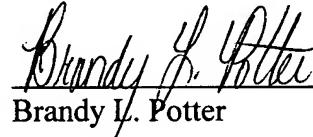
Examiner Timothy J. Neal
Serial # 10/772,763

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

DATE: October 5th, 2006



Brandy L. Potter